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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/519,939

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Paulus Pieter De Wit

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AKZO NOBEL INC.

LEGAL & IP

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EXAMINER

WHITE, EVERETT NMN

ART UNIT

PAPER NUMBER

1623

MAIL DATE

DELIVERY MODE

04/06/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/519,939	Applicant(s) DE WIT, PAULUS PIETER	
	Examiner EVERETT WHITE	Art Unit 1623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2009 and 02 March 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 14 is/are pending in the application.
- 4a) Of the above claim(s) 1-6 and 14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is in response to the Interview with Applicants' Representative filed January 30, 2009.
2. The amendments filed November 4, 2008 has been received, entered and carefully considered. The amendment and interview of January 30, 2009 affects the instant application accordingly:
 - (A) Claim 13 is canceled;
 - (B) Comments regarding Office Action and presented at the interview are drawn to:
 - (I) 112, 1st paragraph rejection for new matter, which has been withdrawn;
3. Claims 1-12 and 14 are pending in the case; Claims 1-6 and 14 are withdrawn from consideration as being drawn to non-election inventions.

Foreign Priority Claimed

4. This application is a 371 of PCT/EP03/07327 International Filing Date: July 7, 2003, which claims foreign priority to EPO 02077756 under 35 U.S.C. 119(a)-(d). An English version has been filed on December 29, 2004.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 7-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Brown et al (US Patent No. 6,545,084 B2).

Applicant claims a solid composition for the preparation of aqueous solutions of low molecular weight polysaccharide ethers with a high solids content, said solid composition comprising a polysaccharide ether and from 2 to 10 wt% of an alkaline depolymerization agent, based on the weight of said polysaccharide ether, characterized in that the alkaline depolymerization agent is selected from the group consisting of sodium percarbonate, carbamide peroxide in combination with a base, sodium persulfate in combination with a base, 3-chloroperoxybenzoic acid (m-CPBA) in combination with a base, and mixtures thereof.

The Brown et al patent discloses preparation of a coating composition that comprises an aqueous emulsion polymer which is suitable for use, when dry (see abstract), wherein preparation of the aqueous emulsion polymer is demonstrated in Example 1 of the Brown et al patent, which comprises mixing various components that include 16.4 g of hydroxyethylcellulose and 0.99 g of sodium persulfate. The amount of hydroxyethylcellulose and sodium persulfate described in Example 1 of the Brown et al patent anticipates the 2 to 10 wt.% alkaline depolymerization agent, based on the weight of the polysaccharide ether described in solid composition of instant Claim 7. See column 8, line 45, 46 and 57 wherein the coating composition comprising the aqueous emulsion polymer of Example 1 is allowed to dry, which anticipates the instantly claimed solid composition of Claims 7-9 and 11.

The intended use recited in the instantly claimed solid composition, which is for preparation of aqueous solutions, is noted, but has not been given weight since a difference in intended use cannot render a claimed composition novel. Note *In re Tuominen*, 213 USPQ 89 (CCPA, 1982); *In re Pearson*, 494 F2d 1399; 181 USPQ 641 (CCPA, 1974); and *In re Hack* 114 USPQ 161.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
8. Claims 7-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown et al (US Patent No. 6,545,084 B2) in view of Biard et al (US Patent No. 4,219,435) or Young (US Patent No. 5,080,717).

Applicant claims a solid composition for the preparation of aqueous solutions of low molecular weight polysaccharide ethers with a high solids content, said solid composition comprising a polysaccharide ether and from 2 to 10 wt% of an alkaline depolymerization agent, based on the weight of said polysaccharide ether, characterized in that the alkaline depolymerization agent is selected from the group consisting of sodium percarbonate, carbamide peroxide in combination with a base, sodium persulfate in combination with a base, 3-chloroperoxybenzoic acid (m-CPBA) in combination with a base, and mixtures thereof.

The Brown et al patent discloses preparation of a coating composition that comprises an aqueous emulsion polymer which is suitable for use, when dry (see

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abstract), wherein preparation of the aqueous emulsion polymer is demonstrated in Example 1 of the Brown et al patent, which comprises mixing various components that include 16.4 g of hydroxyethylcellulose and 0.99 g of sodium persulfate. The amount of hydroxyethylcellulose and sodium persulfate described in Example 1 of the Brown et al patent embraces the 2 to 10 wt.% alkaline depolymerization agent, based on the weight of the polysaccharide ether described in the solid composition of instant Claim 7. See column 8, line 45, 46 and 57 wherein the coating composition comprising the aqueous emulsion polymer of Example 1 is allowed to dry, which embraces the instantly claimed solid composition of Claims 7-9 and 11.

The instantly claimed solid composition differs from the coating composition of the Brown et al patent by specifying the carboxymethyl cellulose and sodium percarbonate in dependent claims as the components of the solid composition.

However, the Biard et al patent discloses a coating composition (see the abstract) wherein sodium percarbonate can be substituted for sodium persulphate (see column 4, line 51).

The Young patent also discloses coating compositions wherein carboxymethyl cellulose can be substituted for hydroxyethyl cellulose (see the Derwent Abstract of the Young patent).

One of ordinary skill in this art would be motivated to combine the teachings of the Brown et al patent with the teaching of the Biard et al and Young patents since each of the patents disclose coating compositions.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the sodium persulfate and hydroxyethylcellulose of the coating composition of the Brown et al patent with sodium percarbonate and carboxymethyl cellulose, respectively, in view of the recognition in the art, as evidenced by the Biard et al and Young patents, that sodium percarbonate is an effective bleaching agent and carboxymethylcellulose is effective as a thickener for coating compositions.

Summary

9. Claims 7-12 are rejected; Claims 1-6 and 14 are withdrawn from consideration as being drawn to non-elected inventions.

Examiner's Telephone Number, Fax Number, and Other Information

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Everett White whose telephone number is 571-272-0660. The examiner can normally be reached on 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shaojia A. Jiang can be reached on 571-272-0627. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Everett White/
Examiner, Art Unit 1623

/Shaojia Anna Jiang/
Supervisory Patent Examiner, Art Unit 1623